

REMARKS

Reconsideration of this application is respectfully requested.

Claims 47, 51, and 52 are pending in this application.

Claims 47, 51, and 52 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to the skilled artisan that the inventors had possession of the claimed invention at the time the application was filed. The Office alleges that the claims encompass a genus of HIV-1 variants, which are not disclosed in the specification.

Applicants traverse the rejection. Claims 47, 51, and 52 are directed to ***generic methods*** for preparing and detecting the presence of HIV-1 RNA. These methods do not require knowledge of the sequence of the HIV-1 virus that is prepared and detected. Thus, applicants need not provide the sequence of all HIV-1 viruses to describe a generic method that will work with all of these viruses. Moreover, the Office has set forth no reasons to doubt that the claimed methods will work regardless of the sequence of the HIV-1 virus that is prepared and detected. Accordingly, applicants respectfully request withdrawal of the rejection.

Claims 47, 51, and 52 were rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for detection of the specific HIV-1 sequences disclosed in the specification, allegedly does not reasonably provide enablement for detection of HIV-1 variants that are not disclosed in the specification.

Applicants traverse the rejection. First, claim 51 does not require “detecting” HIV-1. Thus, the basis for the Office’s rejection of claim 51 is in error, and applicants respectfully request withdrawal of the rejection.

Second, as long as applicants’ specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. § 112, first paragraph, is satisfied. See *In re Fisher*, 166 U.S.P.Q. 18, 24 (C.C.P.A. 1970). Applicants’ specification fulfills this requirement. The methods of claims 47, 50 and 51 do not require knowledge of the sequence of the HIV-1 virus that is prepared and detected. The Office has set forth no reasons to doubt that the claimed methods will work regardless of the sequence of the HIV-1 virus that is prepared and detected. Accordingly, applicants respectfully request withdrawal of the rejection.

Claims 51 and 52 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-6 of U.S. Patent No. 6,627,395. Solely to expedite prosecution of this application and not in acquiescence to this rejection, applicants agree to file a Terminal Disclaimer once applicants have determined the correct inventors and ownership of this application.

Applicants respectfully submit that this application is in condition for allowance. In the event that the Examiner disagrees, he is invited to call the undersigned to discuss any outstanding issues remaining in this application in order to expedite prosecution.

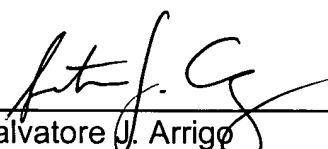
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 25, 2005

By: _____


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